

First named inventor: Hanks  
Serial no. 10/652,005  
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#### REMARKS

The claimed invention has been restricted to as containing claims directed to the following patentably distinct species: Species A of FIGs. 1 and 2; Species B of FIGs. 3 and 4; Species C of FIGs. 5-7B; Species D of FIGs. 8A and 8B; Species E of FIGs. 9 and 11; and, Species F of FIG. 10. Applicant respectfully partially traverses this rejection requirement as follows.

First, there is no patentable distinction between Species C and D. In FIG. 6A (and thus in FIG. 6B) of Species B, for instance, what is depicted is that "the objective focus lens 42 is closer to the storage media 20 than the focal length of the lens 42." (P. 8, para. [25]) In FIG. 7A (and thus in FIG. 7B) of Species B, then, what is depicted is that "the distance from the objective focus lens 42 to the storage media 20 is greater than the focal length of the lens 42." (P. 8, para. [25]) So here we have "two of the three" cases: the first, in FIG. 6A, in which the distance between the lens 42 and the media 20 is less than the focal length; and, the second, in FIG. 6B, in which the distance between the lens 20 and the media is greater than the focal length. Now, in FIG. 8A (and thus in FIG. 8B), what is shown is that "the distance of the focus lens 42 relative to the storage media 20 . . . lie[s] substantially at the focal length distance of the objective focus lens 42." (P. 9, para. [27]) That is, the "third" case is in FIG. 8A, in which the distance between the lens 42 and the media 20 is substantially equal to the focal length.

Thus, what is described in the application in relation to FIGs. 5-8B is the storage medium in FIG. 5, the distance between the lens 42 and the media 20 being less than the focal length in FIGs. 6A and 6B, this distance being greater than the focal length in FIGs. 7A and 7B, and finally this distance being substantially equal to the focal length in FIGs. 8A and 8B. Therefore, it does not make sense to call FIGs. 8A and 8B as a patentably distinct species from FIGs. 5-7B, since FIGs. 8A and 8B simply continue the discussion of FIGs. 5-7B, showing what happens when the focal length is equal to the distance in question, as opposed to being less than or greater than the distance in question. To this extent, Applicant traverses the restriction requirement by submitting

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in this first instance that there should be at most five species: A, B, C/D (in combination), E, and F.

Second, in addition, there is no patentable distinction between Species C/D and any of the other Species A, B, E, and F. Stated another way, what FIGs. 5-8B of Species C/D describes is what can occur in relation to the storage device of Species A or the storage device of Species B, and in relation to which the method of Species E or the method of Species F is performed. The difference between Species A and Species B is whether the label side or the substrate of an optical disc is focused by a storage device. However, focusing such that you have a given distance in relation to a focal length as in Species C/D can pertain to either Species A or Species B. Further, the difference between Species E and Species F is that the latter is more particular than the former in achieving focusing, where Species F uses time differences and Species E does not.

Therefore, it does not really make sense to call Species C/D as patentably distinct from Species A, B, E, and F. Rather, each of Species A, B, E, and F is informed in some way by Species C/D, by virtue of showing how a storage device can focus or not focus (as in Species A and Species B), or by virtue of showing how a method can result in focus or no focus (as in Species E and Species F). While this distinction does not ultimately make a difference as to the election of particular claims for instant examination, it is important so that the restriction requirement is properly made. Thus, Applicant traverses the restriction requirement by submitting in the second instance that there should be at most four species: A, B, E, and F, where What is called "Species C/D" is actually just an *example* and not a patentably distinct species, which is informative to all the Species A, B, E, and F.

With respect to the election that Applicant must make, Applicant first notes that claims 1-8 encompass Species E (and Species C/D insofar as Species C/D illustrates performance of the method of Species E to focus or not focus), whereas claims 9-19 encompasses Species F (and Species C/D insofar as Species C/D illustrate performance of the method of Species F). The difference between Species E and Species F is that the latter explicitly relates to time, whereas the

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former does not necessarily explicitly relate to time. Because claims 9-19 explicitly recite time in some way, and claims 1-8 do not, this is why Applicant has made the distinction between these claims as to Species E and Species F.

Next, Applicant notes that claims 20-24 encompass both Species A and Species B (and Species C/D insofar as Species C/D illustrates how a storage device can focus or not focus). As noted above, the difference between Species A and Species B is whether the storage device focuses on a label side or on a substrate of an optical disc. However, claims 20-24 are not particular to either one, instead just talking about a storage media generally. Therefore, claims 20-24 cannot be segmented to either just Species A or just Species B.

All of the above is a long-winded way to say that Applicant believes that the claims as presently presented at most pertain to three patentably distinct inventions in total: Invention I, related to claims 1-8 and encompassing Species E (and Species C/D); Invention II, related to claims 9-19 and encompassing Species F (and Species C/D); and, Invention III, related to claims 20-24 and encompassing both Species A and Species B (and Species C/D). Applicant hereby elects claims 1-8 for immediate examination. As such, claims 9-24 have been withdrawn.

Respectfully Submitted,



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Date

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